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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,218	10/29/2003	Lori Ann Johnson	9539.18434	7317
26308	7590	09/23/2004	EXAMINER	
RYAN KROMHOLZ & MANION, S.C. POST OFFICE BOX 26618 MILWAUKEE, WI 53226			PAYER, HWEI SIU CHOU	
			ART UNIT	PAPER NUMBER
			3724	
DATE MAILED: 09/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/696,218	JOHNSON, LORI ANN	
	Examiner	Art Unit	
	Hwei-Siu C. Payer	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 and 24-32 is/are pending in the application.
  - 4a) Of the above claim(s) 27-32 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-17, 19, 20 and 24-26 is/are rejected.
- 7) Claim(s) 18 is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_.

## Detailed Action

### Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-20 and 24-26, drawn to an eating utensil, classified in class 30, subclass 324.
  - II. Claims 27-32, drawn to a method of providing oral sensory stimulating utensil feeding, classified in class 434, subclass 127.
2. The inventions are distinct, each from the other because:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used for messaging a baby's back.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Patricia A. Limbach on August 24, 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-20 and 24-26. Affirmation of this election must be made by

applicant in replying to this Office action. Claims 27-32 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

**Claims Rejection - 35 U.S.C. 102(b)**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 5-7, 9-11, 13, 15, 16, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Potente et al. (U.S. Patent No. 4,638,521).

The utensil of Potente et al. shows all the claimed structure. It is held that the concave bowl (18) of Potente et al. is fully capable of carrying food as claimed.

3. Claims 1, 2, 10, 17, 20, 24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoder (U.S. Patent No. 2,826,201).

Yoder's utensil comprises a handle (16), a platform (11), and at least one blunt convex dome-shaped projection (40) of a pliable material extending radially from at least one of the top surface and the bottom surface of the platform (11) as claimed. It is held that Yoder's platform (11) is fully capable of performing the function of carrying food.

4. Claims 1, 3, 5, 8, 10, 11, 13, 14, 16, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Gardner (U.S. Patent No. 1,323,042).

Gardner's utensil comprises a handle (4), a platform having at least one tine (2), and a blunt projection (3) comprising a pliable material and extending radially from at least one of the top surface and bottom surface of the platform (2) as claimed. It is held that Gardner's platform (2) is fully capable of performing the function of carrying food.

5. Claims 1-5, 7, 10-13, 16, 17, 20 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Foley et al. (U.S. Patent No. 5,779,654).

The utensil of Foley et al. shows all the claimed structure. It is held that the platform (40) of Potente et al. is fully capable of carrying food as claimed.

#### **Claim Rejection - 35 U.S.C. 103(a)**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 17, 19, 20 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potente et al. (U.S. Patent No. 4,638,521) in view of Foley et al. (U.S. Patent No. 5,779,654).

The utensil of Potente et al. shows all the claimed structure except for the shape of the projection (26).

Foley et al. show a utensil comprising a tongue scraping projection in the form of a dome shape (140, column 4, lines 17-21).

It would have been obvious to one skilled in the art to modify Potente et al. by substituting the dome-shaped projection of Foley et al. for the ridge-shaped projection of Potente et al. The modification is obvious since it would only involve substituting one known shape of tongue scraping projection for another for scraping a tongue.

Further, it has been held that change in shape is an obvious matter of engineering design choice and not patentably advanced. In re Dailey, 149 USPQ 47, CCPA 1966.

### **Indication of Allowable Subject Matter**

Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### **Prior Art Citations**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wheeler, Metzler, Rimkus and Liebel are cited as art of interest.

**Point of Contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hwei-Siu C. Payer whose telephone number is 703-308-1405. The examiner can normally be reached on Monday through Friday, 7:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for official communications and 703-746-3293 for proposed amendments.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

H Payer  
August 26, 2004

*Hwei-Siu Payer*

Hwei-Siu Payer  
Primary Examiner